



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/209,815	12/11/98	FERSTENBERG	R 8854-0006

PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036

LMC1/0814

EXAMINER

MYHRE, J

ART UNIT

PAPER NUMBER

2767

DATE MAILED: 08/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/209,815

Applicant(s)
Ferstenberg et al

Examiner
James Myhre

Group Art Unit
2767



☒ Responsive to communication(s) filed on May 17, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 87-106 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 87-106 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2767

DETAILED ACTION

Response to Amendment

1. The amendment filed on May 17, 2000 has been considered but is ineffective to overcome the double patenting rejection.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 86-105 have been renumbered 87-106, respectively. The Examiner will refer to the renumbered claims in this action.

3. Claims 92 and 106 are objected to because of the following informalities:
 - a. The independent computer readable medium claims (96 and 106) include references to other independent methods claims (87 and 62, respectively). While this format does not render the claims non-statutory, Examiner recommends the Applicant amends the claims to list the actual

Art Unit: 2767

steps being performed by the computer instructions to more clearly define the scope of the claims;
and

b. Claim 106 makes reference to a canceled claim (62). Examiner believes this is a typographical error, and that the claim should make reference to Claim 102.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 87-106 are rejected under the judicially created doctrine of double patenting over claims 1, 4, 5, 16-18, 22, 23, 27, 62, 64-66, 68-70, 81, and 83 of U. S. Patent No. 5,873,071 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Art Unit: 2767

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the only difference is the first person viewpoint of the same system. While the patented claims describe the system from the viewpoint of the participants computers (buyers), the present application claims describe the same system from the viewpoint of the intermediary computer (seller). It would have been inherent that the system, and methods ran thereon, could be viewed from the viewpoint of any of the system's components. For instance, the patent describes the step of "sending electronic opening messages to an intermediary computer program from said e-agent computer programs" (Claim 69a). The present application describes the same step as "receiving, at an intermediary computer program, electronic opening messages from computer programs representing the participants" (Claim 87a).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2767

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 87-96, 99, and 101-106 are rejected under 35 U.S.C. 102(e) as being anticipated by Ausubel (5,905,975).

Claims 87, 92, 102, and 106: Ausubel discloses a method and computer readable medium with computer instructions for negotiated transactions of commodities (col 7, lines 27-35), comprising:

- a. Receiving at an intermediary computer (seller) a request for commodities from a plurality of participants (buyers) (col 11, lines 5-10);
- b. Sending from the seller to the buyers a message containing an offer generated within the seller's objectives (parameters/guidelines/bidding rules)(col 11, lines 5-10);
- c. Receiving by the seller messages from the buyers containing counter-offers generated within the buyers' objectives (parameters/guidelines/bidding rules)(col 5, lines 5-10);
- d. Repeating steps b and c until an agreement is reached which is within the objectives (parameters/guidelines/bidding rules) of the buyers and seller (col 9, lines 36-38).

Claims 88, 90, 93, and 103: Ausubel discloses a system and method for negotiated transactions of commodities as in Claims 87 and 102 above, and further discloses that the objectives reflect the interests of the buyers (col 11, lines 15-32) and seller (col 11, lines 44-57).

Art Unit: 2767

Claim 89: Ausubel discloses a method for negotiated transactions of commodities as in Claim 87 above, and further discloses sending from the seller to the buyers messages containing data representing commodities available for exchange (col 11, lines 5-10).

Claim 91: Ausubel discloses a method for negotiated transaction of commodities as in Claim 87 above, and further discloses the seller using a parameterized utility function which reflects the interests of the buyers (col 12, lines 39-67).

Claims 94 and 101: Ausubel discloses a system for negotiated transactions of commodities as in Claim 93 above, and further discloses that the offers and counter-offers contain the amounts of the commodity the seller offers and buyers will accept (col 11, lines 15-32).

Claim 95: Ausubel discloses a system for negotiated transactions of commodities as in Claim 93 above, and further discloses terminating the cycle of offers and counter-offers upon acceptance of the terms (col 12, lines 17-19).

Claim 96: Ausubel discloses a system for negotiated transactions of commodities as in Claim 93 above, and further discloses storing bounds set by the seller and buyers and verifying that the transactions remain within these bounds (col 11, line 40 - col 12, line 19).

Claims 99 and 105: Ausubel discloses a system and method for negotiated transactions of commodities as in Claims 93 and 102 above, and further discloses the generating the offer amounts in order to maximize the value of the utility function (col 11, line 40 - col 12, line 19).

Art Unit: 2767

Claim 104: Ausubel discloses a method for negotiated transactions of commodities as in Claim 102 above, and further discloses expressing the objectives according to mean-variance portfolio theory (col 6, lines 50-63).

Allowable Subject Matter

8. Claims 97, 98, and 100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: While it is old and well known within the retail arts to treat all customers as fairly and as equitably as possible, prior art could not be found which disclosed calculating a fairness factor using the algorithms disclosed in the present specification.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Watanabe et al (JP 10-261026) discloses a system and method for negotiated transactions in electronic commerce. This reference is cited to show the state of the art in electronic commerce outside the United States at the time the invention was made.


Art Unit: 2767

b. Micali (5,615,269) discloses a method for electronic negotiations during electronic commerce transactions using trusted agents which do not disclose the identities of the participants until agreement is reached. This reference is cited to show the state of the art in negotiated transactions at the time the invention was made.

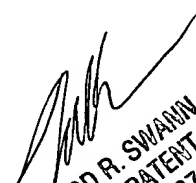
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached on (703) 308-7791. The fax phone number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-3900.


JWM
July 26, 2000


APPROVED
John J. Love
Director, Group 2700


TOD R. SWANN
SUPERVISORY PATENT EXAMINER
GROUP 2700